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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,489	02/05/2004	John Siemens	P68.2-11477-US01	4972
490	7590	12/17/2004	EXAMINER	
VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/772,489	Applicant(s) SIEMENS ET AL.	
	Examiner Daniel I Walsh	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Receipt is acknowledged of the IDS of 29 September 2004. The Examiner notes that US 2,312,275 cited in the IDS appears to be of error, as applicant has mentioned Canadian Patent Application 2,312,275 in the specification. The Examiner has considered the reference as cited by the IDS (the U.S. reference), as no Canadian reference has been provided. Clarification is requested.

Specification

2. The disclosure is objected to because of the following informalities: Re page 4, lines 31: Replace "care" with -- card --.

Appropriate correction is required.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "30" and "100" has been used to designate both a deposit slot/print receipt slot and database/controller. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant

will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner is unclear of pre-approval permitting opening of the deposit opening, as it is not taught in the specification.

Appropriate clarification and correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6 recites the limitation "said status" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Appropriate clarification and correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-4, 6, 9-13, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Hughes (US 2004/0210515).

Hughes teaches a deposit system comprising at least 2 safes (224, 225) having at least one processor controlled deposit opening (paragraph [0025]+), a local processor 252 connected to the safes, having a user interface (FIG. 1) to communicate with the user and being able to communicate with a remote processor 154, and a means for opening a respective one of the processor controlled deposit openings in response to a communication from either said user or said remote processor (paragraph [0061] and also when a user makes a deposit), and the users deposits are sorted as one deposit opening is opened (abstract).

Re claim 2, it has been discussed above that the remote processor can communicate with the local processor.

Re claim 3, the safes are contained in a separate module for flexibility (FIG. 1 and paragraph [0098]).

Re claim 4, separate access openings are provided each safe are taught (locked by combination locks 256 and 257).

Re claim 6, the user must be approved before the device opens (accepts a deposit), where the local processor requests approval for the user from the remote processor, and the remote processor responds to the local processor with a communication of confirmation or rejection of the user (paragraph [0076]+, where the local processor sends data to the remote processor to be validated, and the remote processor sends back approval or rejection of the user before a deposit can occur).

Re claims 9 and 11, the user selects a cash or non-cash transaction to determine which safe is used (abstract).

Re claim 12, a touch screen can be part of the user interface (paragraph [0055]).

Re claim 13, the limitations have been discussed above re claim 1.

Re claim 15, Hughes teaches pre-approval of a user to permit the deposit opening to open, as discussed above via claim 6. The Examiner has interpreted pre-approval as the user being approved before the deposit opening is opened.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes, as applied to claim 1 above.

The teachings of Hughes have been discussed above. Hughes teaches a label that includes an identifier that includes at least one of a user identification, amount of deposit, account number, etc. (paragraph [0036]+). Accordingly, as the label is scanned to open a deposit opening, user identification can be obtained by the scanning, when the label stores such information (as set forth as possible above). Accordingly, it would have been obvious to an artisan of ordinary skill in the art to include user identification on the label, as a means to provide additional identification on the label/bag, in order to provide additional identification information

on the bag, which can be helpful for record keeping, scanning of the bags after pickup, accountability, recording users transaction histories, etc.

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes, as applied to claim 1 above, further in view of Monaghan (US 2002/0065775).

The teachings of Hughes have been discussed above. Hughes teaches that the remote processor controls the depositing unit, as discussed above, including monitoring the ATM to determine when service needs to be scheduled, printer ink filled, etc., as it is well known and conventional to remotely monitor a ATM either by usage or sensors, to maintain the ATM. In accordance, Hughes teaches that the remote processor controls the local processor to shut the drawers completely (locking), and that as a precautionary measure, failure to shut the drawers will trigger the local processor to cease taking further deposits and to contact the remote processor to send security or maintenance personnel to the situation (paragraph [0088]). Re claim 7, sensors provide status information of the deposit system from to the remote processor (paragraph [0064] +). Though Hughes is silent to the information going from the local processor to the remote processor, the Examiner notes its well known and conventional for status information to be provided to the remote processor, in order for the remote processor to monitor and control the ATM (see below, as well). Additionally, status information is understood to be communicated from the local processor to the remote processor, such as when the slots are not able to be closed and the local processor contacts the remote processor to send service/security.

However, though Hughes teaches that the remote processor communicates a request to service providers, and though the remote processor is taught as controlling the ATM, Hughes is

silent to the remote processor responding to the local processor with a communication to cease accepting deposits.

As mentioned above, it is well known that the processors of ATMs communicate with a central host/station/computer in order to send diagnostic messages regarding the state of the ATM. Specifically, Monaghan teaches that an error message is sent from a ATM, received by a remote processor, and that numerous commands (table 170) can be selected to remedy the situation, including shutting down the ATM (FIG. 6) which includes not accepting anymore deposits. The Examiner notes that is well within the skill in the art to implement other commands to the ATM, depending on the situation, which could include shutting down the printer if ink is out, disabling the depositing ports, or disabling dispensing ports, etc.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Hughes with those of Monaghan.

One would have been motivated to do this, in order to remotely monitor and control the operations of an ATM/deposit machine, based on the conditions of the ATM, for example, to ensure that the ATM is being operated correctly, and when components are damaged, inks are low, errors are detected, etc., that such components can be disabled until service/security arrives, in order to prevent further problems. Further, the Examiner notes that as Hughes teaches sensors on serviceable equipment to monitor it in order to send out service personnel when appropriate (paragraph [0064]), it would have been obvious to an Examiner of ordinary skill in the art to disable/cease accepting deposits when the sensors are tripped, in order to prevent further problems with the ATM operations, as it is well known and conventional in the art to control ATMs remotely.

9. Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes, as applied to claim 13, above.

Re claim 14, the limitations have been discussed above re claim 13. Though Hughes is silent to communicating the deposit information to the remote processor when the deposit is made, it has been taught above that the remote processor is in communication with the local processor, and manages the depositing units (paragraph [0057]). Further, Hughes teaches that the banks will be able to know how many transactions each deposit unit has completed as well as the amount of each in order to provide intelligent service/support (paragraph [0090]). Accordingly it would have been obvious to an Examiner of ordinary skill in the art to send records, including those of deposits, back to the remote processor, in order to have a centralized record in order to account for transactions, money, and service schedules, as is it well known and conventional in the art that ATMs can be monitored and controlled remotely.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Chigira et al. (US 2004/0217162), Ferraro (US 2004/0173671), Magee et al. (US 2004/0099726), Bellucci (US 2004/0083175), and Anderson et al. (US 3,956,615).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[daniel.walsh@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set for the in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

DW
3/2/04



KARL D. FRECH
PRIMARY EXAMINER